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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,716	11/15/2001	Katsuhiko Senda	2001_1659A	7674

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EXAMINER-

HAQ, NAEEM U

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/987,716

Applicant(s)

SENDA, KATSUHIKO

Examiner

Naeem Haq

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-3 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-3 are not within the technological arts because the steps of registering, selecting, providing, and receiving can be performed manually and do not require any technology. (*Ex parte Bowman*, 61 USPQ2d, 1665,1671 (Bd. Pat. App. & Inter. 2001)). Although Bowman is not precedential, it has been cited for its analysis.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claim 2 is dependent on claim 1 which recites in the preamble that each step is "undertaken by the vendor". Since claim 2 merely recites an additional step to further limit claim 1, the step of claim 2 must also be performed by the vendor. However, claim

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2 explicitly recites a step that is performed by the mediator agent and not the vendor. It is unclear to the Examiner how the step of claim 2 is performed by the vendor as required by the preamble of claim 1.

Claims 2 and 3 recite a conditional limitation. It is unclear to the Examiner what the scope of claims 2 and 3 is when the conditional statement is not true. For example, claim 3 recites the conditional limitation that the vendor must pay a breach penalty to the agent if the vendor refuses to vend the objective to the vendee. The scope of the claim is indefinite in the event the vendor consummates the transaction by vending the objective to the vendee. For examination purposes, the Examiner will assume that the conditional statements are not true because one of ordinary skill in the art would recognize that such a scenario a possible outcome in any commercial transaction and because such a scenario is reasonably supported by the Applicant's disclosure. A similar analysis applies to claim 2.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broerman (US 6,594,633 B1) in view of Official Notice.

Referring to claim 1, Broerman teaches a business procedure for mediation of vending between a vendor for vending an objective and a mediator agent, comprising: registering the objective for vending offered by the vendor in a registration system operated by an operating organization (column 2, lines 38-44; column 7, lines 17-32; column 9, lines 9-24); selecting and appointing a mediator agent registered in advance as a member in the operating organization (column 4, lines 1-23); providing the selected mediator agent with information relative to the objective for vending by mediation (column 4, lines 13-23; column 6, lines 19-26). Broerman teaches receiving a bid of a price of the objective for vending from a buyer (column 6, lines 19-40). Broerman does not teach at least two mediator agents. However, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to have more than one agent. Applicant has not disclosed that having at least two agents provides an advantage, is used for a particular purpose or solves a stated problem. Furthermore, one of ordinary skill in the art would have expected Applicants' invention to perform equally well with one agent because the final sale price of the objective is determined by the buyer and not the agent. Therefore, it would have been obvious to one of ordinary skill in this art to modify the prior art to obtain the invention as specified in the claims. Broerman does not teach providing the mediator agent with ratios of a guaranteed minimum price or an amount of breach penalty payable by the mediator agent, a price for obligatory acceptance by the vendor or an amount of breach penalty payable by the vendor and the price for exemption of the mediator agent from obligation for minimum guarantee each to the assessed price to be made by the mediator agent. However, the Examiner

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notes that these limitations are not functionally involved in the steps of the recited method. Therefore these limitations are deemed to be nonfunctional descriptive material. The steps of registering, selecting, providing, and receiving would be performed the same regardless of what information was provided to the agent. The difference between the content of the Applicant's data and the prior art is merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide any information to the agent in the invention of Broerman because such information does not functionally relate to the steps of the method claimed and because the subjective interpretation of information does not patentably distinguish the claimed invention. Broerman does not teach receiving price and business profile information from an agent. However, Official Notice is taken that it is old and well known in the art to receive both price and business profile information from an agent in a real estate transaction. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the invention of Broerman. One of ordinary skill in the art would have been motivated to do so in order to allow the seller to review all of the information about the agent before deciding on establishing a business relationship with the agent. Finally, Broerman teaches receiving from the agent a recommendation of a candidate vendee (column 6, lines 41-62; column 7, lines 54-67).

Referring to claims 2 and 3, as noted above in the 112 rejection these claims recite a conditional statement that can be true or false but not both at the same time. For examination purposes, the Examiner will assume that the conditional statements are false because one of ordinary skill in the art would recognize that such a scenario a possible outcome in any commercial transaction and because such a scenario is reasonably supported by the Applicant's disclosure. Therefore these claims are given little patentable because the steps of the claims are not performed when the conditional statement is false.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on (703)-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naeem Haq, Patent Examiner
Art Unit 3625

March 20, 2005



WYNNE W. COGGINS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600